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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,019	03/03/2005	Guillaume Sebire	879A.0030.U1(US)	3593
29683 7590 08/30/2007 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE SHELTON, CT 06484-6212			EXAMINER BALAOING, ARIEL A	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/501,019	Applicant(s) SEBIRE ET AL.	
	Examiner Ariel Balaoing	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication:
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the method comprises using of said spare bit for indicating whether said cell supports an UMTS service, and **in a favourable case** describing a second broadcast control channel in the second message to at least IU mobile stations," (lines 6-10). It is unclear as to when or if the limitations following the term "**favourable case**" occur as it is unclear as to what constitutes a favorable case as described in claim 1.

Claims 2-8 are rejected for being dependent on an indefinite claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view of ETSI 3GPP 04.18 v 9.0.

Regarding claim 1, MILDH discloses a method for broadcasting of a possibility to use UMTS service **26** in a cell under control of a GERAN type radio access network **20**, **24** having an lu interface to a 3G core network **22**, a radio resource management system of the radio access network comprising a first and

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a second message, which messages are transferred on a first broadcast control channel in said cell [BCCH], and which first message has at least one spare bit, wherein said first message is System Information 2 of GSM system (paragraph 16-21), and in a favourable case describing a second broadcast control channel [PBCCH] in the second message to at least 1u mobile stations (paragraph 22-33), and broadcasting UMTS service information for 1u mobile stations on the second broadcast control channel (paragraph 6, 8-10, 16-18). Although MILDH discloses the use of System Information type messages, MILDH does not disclose wherein the first message is a System Information 3 message and using of said spare bit for indicating whether said cell supports an UMTS service. In the same field of the endeavor, ETSI 3GPP 04.18 v 9.0 discloses wherein a message is a System Information 3 message and using of a spare bit for indicating whether said cell supports a service (pages 142-143, section 9.1.35; Cell Options/Cell Selection). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include the use of System Information 3, as taught by ETSI 3GPP 04.18 v9.0, since System Information 3 is used by GSM networks to provide network information and control.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses said first channel being BCCH of the GSM system and said second channel being PBCCH of the GSM system (paragraph 19).

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Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the radio access network supporting the UMTS-service and not supporting a GPRS service, wherein said first message further comprises an lu indicator field (paragraph 6, 15-18). However, MILDH does not expressly disclose wherein said second message is System Information 13alt of the GSM system and is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a second message is System Information 13 of the GSM system and is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is used by GSM networks.

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However MILDH does not disclose wherein said second message is System Information 13 of the GSM system. ETSI 3GPP 04.18 v 9.0 discloses wherein a second message is System Information 13 of the GSM system (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is used by GSM networks.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However MILDH does not disclose wherein said message System Information 13 is legible only to Iu mobile stations and Gb mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein said message System Information 13 is legible only to Iu mobile stations and Gb mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is used by GSM networks.

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being not available to the GPRS service (paragraph 6, 15-18). However MILDH does not disclose wherein a description of the second channel in the message System Information 13 is legible only to Iu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a description of the second channel in the message System Information 13 is legible only to Iu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is used by GSM networks.

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses said cell being barred against UMTS operation through lu interface by indicating with said spare bit that UMTS service is not supported in said cell (paragraph 11, 15-19).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view of ETSI 3GPP 04.18 v 9.0 as applied to claim 3 above, and further in view of RAITH (US 5,930,706).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses However, the combination of MILDH (US 2002/0193139 A1) and ETSI 3GPP 04.18 v 9.0 does not expressly disclose said lu to transfer the second message (paragraph 6, 11, 15-18). However, MILDH does not expressly disclose an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message. RAITH discloses an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message (paragraph 21, line 22-57).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of MILDH (US 2002/0193139 A1) and ETSI 3GPP 04.18 v 9.0 to include an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message as taught by RAITH, since RAICH teaches that such a modification would allow a system to transmit information at various rates depending on importance.

### ***Conclusion***



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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DALSGAARD et al (US 6,546,251 B1) – Method and arrangement for changing cells

ABRAHAMSON et al (US 2004/0109431) – Techniques for supporting GSM to W-CDMA reselection

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ariel Balaoing – Art Unit 2617

AB



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